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No. 91-296

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1991

INSTITUTE FOR SCIENTIFIC INFORMATION, INC.,
Petitioner,

v.

GORDON AND BREACH, SCIENCE PUBLISHERS, INC.
AND SCIENTIFIC TECHNICAL BOOK SERVICE, LTD.,
Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

RESPONSE TO PETITION FOR WRIT OF CERTIORARI

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RULE 29.1 STATEMENT

Respondents in these proceedings are Gordon and Breach Science Publishers, Inc., and Scientific Technical Book Service, Ltd., which are independent entities and neither of which has a parent corporation or subsidiaries that are not wholly owned.

TABLE OF CONTENTS

RULE 29.1 STATEMENT i

TABLE OF CONTENTS ii

TABLE OF AUTHORITIES iii

COUNTERSTATEMENT OF THE CASE 1

REASONS FOR DENYING THE WRIT 3

A. The Court of Appeals Correctly Held That A Determination That An Incontestable Trademark Is Descriptive Is Not An Attack On The Validity Of That Trademark Prohibited By Park 'N Fly. 4

B. A Determination That A Trademark Is Descriptive Is Relevant To A Fair Use Defense To A Charge Of Infringement. 5

C. The Decision Of The Third Circuit Is Consistent With This Court's Prior Decisions And With The Decisions Of Other All Other Federal Courts. 7

CONCLUSION 8

TABLE OF AUTHORITIES

Cases:

A.J. Canfield Co. v. Vess Beverages, Inc.,
796 F.2d 903 (7th Cir. 1986) 7

Abercrombie & Fitch Co. v. Hunting World, Inc.,
537 F.2d 4 (2d Cir. 1976) 7

Clarke v. Joseph H. Dahlkemper, Inc.,
468 F. Supp. 441 (W.D.Pa. 1979) 6

Cullmann Ventures, Inc. v. Columbian Art Works, Inc.,
717 F. Supp. 96 (S.D.N.Y. 1989) 7

Eli Lilly & Co. v. Revlon, Inc.,
577 F. Supp. 477 (S.D.N.Y. 1983) 6

Engineered Mechanical Services, Inc. v. Applied Mechanical Technology, Inc.,
584 F. Supp. 1149 (M.D.La. 1984) 6

Jablonski v. Pan American World Airways, Inc.,
863 F.2d 289 (3d Cir. 1988) 7

Munters Corp. v. Matsui America, Inc.,
730 F. Supp. 790 (N.D.Ill. 1989) 2

Park 'N Fly v. Dollar Park And Fly, Inc.,
469 U.S. 189 (1985) 2,4,5,7

Schmid Laboratories v. Youngs Drug Products Corp.,
482 F. Supp. 14 (D.N.J. 1979) 6

Seaboard Seed Co. v. Bemis Co., Inc.,
632 F. Supp. 1133 (N.D.Ill. 1986) 5

Tree Tavern Products, Inc. v. Conagra, Inc.,
640 F. Supp. 1263 (D.Del. 1986) 6

Zatarains, Inc. v. Oak Grove Smoke House, Inc.,
698 F.2d 786 (5th Cir. 1983) 5,6,7

Statutes:

Lanham Act, 15 U.S.C. §1065 3

Lanham Act, 15 U.S.C. §1115(b)(4) 2,5

Rules:

Fed.R.Civ.P. Rule 12(c) 2

Miscellaneous:

1 J. McCarthy Trademarks and Unfair Competition
§11:17 (1984 and 1990 Supp.) 5,7

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COUNTERSTATEMENT OF THE CASE

Respondent Scientific Technical Book Service, Ltd. ("STBS") distributes free of charge a periodical under the title SCAN. App. A-22.[1] SCAN has been accurately described on its front cover and in advertising as "a free guide to the current contents of books and journals published by Gordon and Breach and Harwood Academic

[1] The facts recited in this section are derived from the findings of fact in the District Court's Memorandum Opinion. References designated "App. A-" are to the appendix to Petitioner's Brief.

Publishers," and by other variations of that phrasing. App. A-25. STBS is the distributor for the journals published by respondent Gordon and Breach, Science Publishers, Inc. (for ease of reference both respondents will be referred to collectively as "Gordon and Breach").

Petitioner Institute for Scientific Information, Inc. ("ISI") has complained that the use of the words "current contents" in the description of SCAN infringed its registered trademark "CURRENT CONTENTS" for a publication that similarly lists the current contents of various scholarly publications. App. A-23.

Respondents moved for judgment on the pleadings pursuant to Rule 12(c) of the Federal Rules of Civil Procedure, arguing that the use of the words "current contents" as complained of by ISI was a noninfringing fair use permitted by §33(b)(4) of the Lanham Act, 15 U.S.C. §1115(b)(4). App. A-23. The District Court found that the words "current contents" were descriptive both as used as a trademark by petitioner, App. A-25, and in the description employed by respondents. App. A-25-26. The District Court found the "fair use" defense applicable and dismissed the action. App. A-28.

On appeal, the Court of Appeals for the Third Circuit vacated the ruling of the District Court, holding that petitioner's allegations raised material issues of fact as to respondents' good faith use of the words. App. A-16-17. Good faith use by the defendant is one of the three elements of the fair use defense.[2]

In so doing, however, the Court of Appeals rejected petitioner's contention that the District Court had erred in concluding that petitioner's mark CURRENT CONTENTS was "clearly descriptive." Petitioner argued that the District Court's conclusion was precluded by this Court's decision in *Park 'N Fly v. Dollar Park And Fly, Inc.*, 469 U.S. 189 (1985), because plaintiff's mark had become incontestable. However, the Court of Appeals determined

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[2] "The elements of the fair use defense are: 1) that the defendant used the word or symbol to merely describe its product; 2) that it did not use the word or symbol as a trademark; and 3) that it used the word or symbol in question in good faith." District Court Opinion at App. A-23-24, *quoting, Munters Corp. v. Matsui America, Inc.*, 730 F. Supp. 790, 800 (N.D.Ill. 1989) (citing 15 U.S.C. § 1115(4)(b)).

that the District Court had not been addressing the validity of the mark on grounds of descriptiveness, but rather had been analyzing whether the term "current contents" was capable of conveying a descriptive meaning. App. A-17. Indeed, the District Court had made this analysis of the terms first as used in connection with petitioner's publication and then with respect to respondents' publication in assessing the fair use defense raised by respondents. App. A-17-18. Petitioner unsuccessfully sought hearing *en banc* with respect to this issue. App. A-21.

REASONS FOR DENYING THE WRIT

The decision of the Court of Appeals, holding that it was not error for the District Court to determine that petitioner's trademark is descriptive, where the District Court did not address the validity or incontestability of the mark, does not conflict with decisions of this Court or of any Court of Appeals, and does not present any issue for review by this Court.

The questions raised by petitioner present no issues requiring resolution by this Court. Indeed, there is no disagreement between the parties concerning the applicable principles of law. Respondents agree with petitioner that once a trademark becomes incontestable under §15 of the Lanham Act, 15 U.S.C. §1065, the validity of that trademark may not be attacked, nor a charge of infringement defended, on the grounds that the mark is merely descriptive. Respondents also agree with petitioner that the test for determining the defense of fair use is whether the defendant uses the mark in a descriptive sense. Finally, respondents agree that a fair use defense does not require that the plaintiff's trademark be found to be descriptive; however, the descriptiveness of the mark may be relevant to the assessment of the defense.

Respondents strongly disagree with ISI's characterization of the proceedings below. Gordon and Breach defended ISI's charge of infringement on the grounds that Gordon and Breach's use is a fair use of the words "current contents." By necessity, this required an assessment of whether the words bear a descriptive meaning in the context of the defendants' use of the words. Neither the respondents nor the District Court have questioned or attacked the validity of petitioner's United States trademark registration.

Petitioner's argument misconstrues the decision of the District Court as challenging the validity of the mark by confusing the distinction between (1) the determination of whether words are used in a "descriptive" sense in the context of the fair use defense and (2) the characterization of a mark as "descriptive" in the context of a defense to trademark infringement.

A. The Court of Appeals Correctly Held That A Determination That An Incontestable Trademark Is Descriptive Is Not An Attack On The Validity Of That Trademark Prohibited By *Park 'N Fly*.

The heart of Petitioner's argument is that the Court of Appeals misconstrued *Park 'N Fly* by allowing to stand the District Court's determination that ISI's mark "CURRENT CONTENTS" is "clearly descriptive" for the reason that such determination challenges the validity and incontestability of the mark. Petitioner's Brief at 7. This argument misstates the law as derived from *Park 'N Fly* and §15 of the Lanham Act, and mischaracterizes the decisions of both the Court of Appeals and the District Court.

In *Park 'N Fly* this Court held that the owner of a registered mark could rely on the incontestability of that mark offensively to enjoin infringement by another and that infringement could not be defended on the grounds that the mark was merely descriptive. 469 U.S. at 205.

A far different situation is presented in this case. Gordon and Breach has defended ISI's charge of infringement by asserting that its use of the common words "current contents" in a descriptive, non-trademark use is a fair use. No question of the validity of the mark CURRENT CONTENTS has ever been raised. Respondents have not attacked ISI's mark as descriptive, or ISI's right to use its mark, but have only attempted to show that their own use of the words is in fact a fair use, and thus not infringing. Thus, the District Court's descriptiveness determination arose in the context of determining the nature of the words at issue, "current contents" and not as an attack on the petitioner's mark. This does not conflict with the holding of *Park 'N Fly*, which precludes a defense to

infringement upon a determination that a plaintiff's mark is descriptive.

B. A Determination That A Trademark Is Descriptive Is Relevant To A Fair Use Defense To A Charge Of Infringement.

The fair use defense is found in §33 of the Lanham Act, which provides, in pertinent part:

> (b) To the extent that the right to use the registered mark has become incontestable under section 15, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. . . subject to the following defenses or defects:
>
> * * *
>
> (4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark. . . of a *term or device which is descriptive of and used fairly and in good faith only to describe the goods or services* of such party.

15 U.S.C. §1115(b)(4) (emphasis added).

The fair use defense focuses on the defendant's descriptive use of the mark. *See* 1 J. McCarthy Trademarks and Unfair Competition §11:17 (1984 and 1990 Supp.). An essential element of the defense is that the term or device be capable of conveying a descriptive meaning. *See Park 'N Fly,* 469 U.S. at 201 ("The Lanham Act...permits the non-trademark use of descriptive terms contained in an incontestable mark."). Thus, courts have held that the fair use defense is not a challenge to the incontestability of the mark. *Seaboard Seed Co. v. Bemis Co.*, Inc., 632 F. Supp. 1133, 1138 (N.D.Ill. 1986); *See Zatarains, Inc. v. Oak Grove Smoke House, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983) ("The holder of a protectable descriptive mark has no legal claim to an exclusive right in the primary, descriptive meaning of the term."). Where, as here, the competing products are similar, it is relevant to determine if the

mark is capable of describing the product in assessing whether the defendant's use is descriptive. *See Zatarains*, 698 F.2d at 793-796; *Tree Tavern Products, Inc. v. Conagra, Inc.*, 640 F. Supp. 1263, 1265-1269 (D.Del. 1986); *Engineered Mechanical Services, Inc. v. Applied Mechanical Technology, Inc.*, 584 F. Supp. 1149, 1156-1158 (M.D.La. 1984); *Eli Lilly & Co. v. Revlon, Inc.*, 577 F. Supp. 477, 484-486 (S.D.N.Y. 1983); *Schmid Laboratories v. Youngs Drug Products Corp.*, 482 F. Supp. 14, 21 (D.N.J. 1979); *Clarke v. Joseph H. Dahlkemper, Inc.*, 468 F. Supp. 441, 442 (W.D.Pa. 1979).

In analyzing fair use, the District Court below first examined whether the words at issue, "current contents" are descriptive. App. A-24. The Court had defined the term "descriptive" in the trademark context and then analyzed both ISI's use of the mark for its publication and Gordon and Breach's use of the words in its description. The court had noted the similarity between the nature of the publications, App. A-22, and had analyzed the trademark as used in order to assess the descriptiveness of the terms of the mark. App. A-25. The District Court found that the complained of use was

> a page topped by the word "SCAN" in large letters, with the following words beneath in much smaller letters: "...a free guide to the current contents of books and journals published by Gordon & Breach Science Publishers and Harwood Academic Publishers." This is not a trademark use of the words "current contents," it is a description of the nature of the defendant's publication, which is the current contents of the books and journals that they publish. The fact that the description contains the words "current contents" does not turn it into a trademark. The words "current contents" have a normal dictionary meaning, and defendants use the words in that sense.

App. A-25.

The court's determination that Gordon and Breach used the words descriptively did not depend on its assessment of ISI's trademark as descriptive. As the Court of Appeals noted, the District Court examined ISI's mark to determine if the words were capable of descriptiveness. App. A-17. Because the District Court

had been ruling on a motion for judgment on the pleadings, only the facts as presented in the pleadings could be considered. *Jablonski v. Pan American World Airways, Inc.*, 863 F.2d 289, 290-291 (3d Cir. 1988). Thus, in assessing whether the words "current contents" could bear a descriptive meaning, the court was limited to what was before it, *i.e.*, the uses by the parties.

C. The Decision Of The Third Circuit Is Consistent With This Court's Prior Decisions And With The Decisions Of Other All Other Federal Courts.

Petitioner overstates the holding of *Park 'N Fly* to the extent it argues that the preclusion of a defense to infringement based on the alleged descriptiveness of an incontestable trademark extends to the fair use defense. Neither this Court nor any other has held that a court may not analyze the nature of the trademark in issue in the fair use defense. As this Court stated in *Park 'N Fly*, incontestable status under the Lanham Act does not allow a descriptive mark to take from the public domain, or commercially monopolize, language that is merely descriptive because the Act provides several defenses, including the fair use defense, for the non-trademark, descriptive use of the language. *Park 'N Fly*, 469 U.S. at 201. Thus, the fact that the trademark in issue is descriptive is not isolated from consideration, but is relevant to determining the fair use defense. This has been generally recognized by both courts and one commentator. *See Zatarains*, 698 F.2d 786; *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976); *Cullmann Ventures, Inc. v. Columbian Art Works, Inc.*, 717 F. Supp. 96, 132 (S.D.N.Y. 1989); 1 McCarthy, §11:17.

Descriptiveness in the context of fair use is different from that of descriptiveness in the context of a defense to infringement, where the inquiry focuses on whether the mark in issue is capable of functioning as a trademark or merely describes the goods. *See Park 'N Fly*, 469 U.S. at 194, 195. In the fair use defense, the inquiry is directed to whether defendant has used the words not as a trademark and as descriptive of defendant's goods. *See A.J. Canfield Co. v. Vess Beverages, Inc.*, 796 F.2d 903, 908 (7th Cir. 1986).

Thus, the District Court did not err in considering the nature of plaintiff's trademark in the context of the fair use defense, and the Court of Appeals properly recognized that this was relevant to whether the terms were capable of functioning descriptively for respondents' publication.

CONCLUSION

Because the decision of the Court of Appeals raises no conflict with a decision of this Court or of another Court of Appeals, nor does it raise an issue of first impression requiring a decision by this Court, the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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